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In re Application of:
HSIAO, Wen-Laun Wendy, et al. :
U.S. Application No.: 10/516,864 :
PCT No.: PCT/US03/20587 :
International Filing Date: 27 June 2003 :
Priority Date: 28 June 2002 :
Attorney's Docket No.: 32144183.4 :
For: PLASMA OR SERUM MARKER AND :
PROCESS FOR DETECTION OF :
CANCER :

DECISION ON PETITION UNDER
37 CFR 1.47(a)

This decision is issued in response to applicants' "Response To Notice To File Missing Parts Of Application" filed 06 October 2005, treated in part herein as a petition under 37 CFR 1.47(a). Deposit Account No. 50-3420 will be charged the \$200 petition fee.

BACKGROUND

On 27 June 2003, applicants filed international application PCT/US03/20587 which claimed a priority date of 28 June 2002 and which designated the United States. The deadline for submission of the basic national fee was thirty months from the priority date, i.e., 28 December 2004.

On 03 December 2004, applicants filed a Transmittal Letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee.

On 06 July 2005, the United States Designated/Elected Office (DO/EO/US) mailed a Notification Of Missing Requirement (Form PCT/DO/EO/905) indicating that an executed declaration in compliance with 37 CFR 1.497, the surcharge for filing the declaration later than thirty months after the priority date, and sequence listing materials were required.

On 06 October 2005, applicants filed a response to the Notification Of Missing Requirements (with required extension fee) which included the required sequence listing materials and the additional materials considered herein as a petition under 37 CFR 1.47(a). The petition seeks acceptance of the application without the signature of co-inventor Sze-Chuen Cesar WONG, whom applicants argue has refused to execute the application.

DISCUSSION

A grantable petition under 37 CFR 1.47(a) must be accompanied by: (1) the fee under 37 CFR 1.17; (2) a statement of the last known address of the nonsigning inventor; (3) an oath or declaration executed by the other inventors on behalf of themselves and the nonsigning inventor; and (4) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort.

Here, applicants have authorized a charge to Deposit Account No. 50-3420 for required fees. Based on this authorization, the Deposit Account will be charged the required \$200 petition fee. Item (1) is therefore satisfied.

The petition does not expressly state the last known address of the nonsigning inventor. Item (2) is therefore not satisfied.

Regarding item (3), section 409.03(a) of the Manual of Patent Examining Practice (MPEP) states that:

An oath or declaration signed by all the available joint inventors with the signature block of the nonsigning inventor(s) left blank may be treated as having been signed by all the joint inventors on behalf of the nonsigning inventor(s), unless otherwise indicated.

Applicants here have not filed an acceptable declaration executed by inventor Wen-Luan Wendy HSAIO and containing an unsigned signature block for the nonsigning inventor Sze-Chuen Cesar WONG. Neither of the two inventorship declarations included in the international application are in acceptable form. The first such declaration (Sheet 7 of the Request) is executed by Wen-Luan Wendy HSAIO, but the declaration does not identify the second inventor. The second such declaration (Sheet 8 of the Request) includes an unsigned signature box identifying the nonsigning inventor; however, this declaration does not identify, and is not signed by, inventor HSAIO. On both of these declarations, the space in which the name of the second inventor should have been entered was left blank.¹ Based on the above, applicants have failed to submit an acceptable declaration executed by the cooperating inventor and containing an unsigned signature block for the nonsigning inventor. Accordingly, item (3) is not satisfied.

Regarding item (4), MPEP section 409.03(d) states that, before it can be concluded that an inventor has refused to join in the application, “[a] copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney.” The MPEP also states the following:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application

¹ The present petition also includes a copy of a separate, unsigned declaration that was apparently forwarded to the nonsigning inventor for signature. It is noted that, even if executed, this declaration would not be acceptable in that it fails to identify both of the inventors herein.

papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Here, applicant has provided a statement of facts, with supporting evidence, confirming that a copy of the complete application papers and declaration were forwarded to the nonsigning inventor by email and by hand delivery to his last known address. The statement also provides evidence that, upon learning that the last known address of the inventor was no longer current, the application materials were delivered to the inventor at his place of employment. Based on this submission, item (4) is satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of the petition is desired, a proper response must be filed within **TWO (2) MONTHS** of the mail date of the present decision. Any request for reconsideration should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)" and must include the materials required to satisfy items (2) and (3) of a grantable petition, as discussed above, that is, an express statement of the last known address of the nonsigning inventor and a declaration executed by the cooperating inventor that includes an unsigned signature block for the nonsigning inventor and all other information required under 37 CFR 1.497. No additional petition fee is required.

Failure to file a proper response will result in abandonment of the application.
Extensions of time are available under 37 CFR 1.136(a)

Please direct further correspondence with respect to this matter to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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